

Docket No.: 1614.1362

Serial No. 10/664,024

REMARKS

In accordance with the foregoing, claims 1, 13, 14, 16-18 have been amended and new claims 19-24 added. Claims 1-24 are pending and under consideration.

ITEM 2: REJECTION OF CLAIMS 16-18 UNDER 35 U.S.C. 102(b) FOR ANTICIPATION BY SEKINE ET AL. (U.S. PATENT 5,903,822)

The rejection is respectfully traversed.

The Examiner asserts that claims 16-18 of the instant application are disclosed in Fig. 41 and at column 12, lines 13-28 of Sekine et al., USP '822. To the contrary of the Examiner's contention, Applicants respectfully submit that Sekine et al. merely discloses a high resistance wire 109 for connecting first and second chassis; clearly, it does not disclose the structure recited in independent claim 16 wherein: "a surface of one of the connection parts at the second chassis part connecting to the one of the connection parts at the first chassis part is made of non-conductive material."

Claim 17 depending from claim 16 is submitted to distinguish over the reference for at least the reason that it inherits the distinguishing recitations of independent claim 16 and further for the recitations of claim 17 as well.

REJECTION OF CLAIM 18 IS DEFECTIVE

Claim 18 is merely set forth at page 3, the second paragraph, of the Action and no reasons for the rejection of same are provided. As such, the Action is defective, as Applicants have pointed out hereinabove, and it is requested that a replacement Action be issued addressing the patentability of claim 18/16 -- or explaining the Examiner's reasons for rejecting same.

Applicants note that claim 18 relates to the structure illustrated in Figs. 23 and 24 and discussed at page 39, lines 5-29 of the specification. Moreover, the conductive member 902 as readily seen in both figures affords an electric notch of a length "S" between the lower part chassis 600 and the conductive member 902, in both the folded and unfolded states of the portable phone 200.

It is submitted that no such teaching or even any suggestion corresponding to the structure defined in claim 18 is presented in the reference.

Docket No.: 1614.1362

Serial No. 10/664,024

At page 2 of the Action, the Examiner reads the final clause of claim 16 on the reference as follows:

wherein only a surface of one of the connection parts (109) at the second chassis part (105) connecting to the one of the connection parts (109) at the first chassis part (20) is made of non-conductive material (high resistance material which is non-conductive) (col. 12, lines 13-28).

This reading is incorrect. Particularly, there is no teaching in the reference with regard to any "surface" of the connection part 109; to the contrary, the schematic illustration of element 109 suggests that it is a resistor of high resistance value connected by typical lead wires at opposite ends to the housings 102a and 102b.

Moreover, there is no teaching to the effect of "only a surface of one of the connection parts at the second chassis part connecting to the one of the connection parts at the first chassis part...[being]... made of non-conductive material."

REJECTION OF CLAIMS 1-7

ITEM II: REJECTION OF CLAIMS 1-7 UNDER 35 U.S.C. 103 (a) AS BEING UNPATENTABLE OVER SEKINE ET AL.

The rejection is respectfully traversed.

In a telephone conference with Examiner Lana Le on July 31, 2006, Applicant's undersigned counsel proposed amending claim 1 to further clarify the "electric notch" in the last line of the claim as originally filed. In the interview, the Examiner initially considered claim 1 to read on Fig. 41 of the reference but was persuaded, after further consideration of the proposed amendment to claim 1, to agree to the patentability of claim 1 -- and claim 1 is so amended in the foregoing and is submitted to distinguish patentably over Sekine et al.

ITEM 3: REJECTION OF CLAIM 12 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER SEKINE ET AL. IN VIEW OF ITOH (U.S. PATENT 5,999,831)

The rejection is respectfully traversed.

Docket No.: 1614.1362

Serial No. 10/664,024

Claim 12 depends from independent claim 6 and hence incorporates the limitations of claim 6, which have been shown hereinabove to distinguish patentably over Sekine et al. and correspondingly distinguish claim 12 over the reference as well.

The secondary reference to Itoh is not relied upon as overcoming the deficiencies of Sekine for rendering claim 6 unpatentable and, accordingly, the combination as well does not render claim 12 unpatentable. Furthermore, Applicants do not understand the last three lines of the rejection appearing at page 7, lines 2-4 of the Action and accordingly request clarification. Those lines furthermore are advanced as the basis for supporting the alleged obviousness of the combination -- and hence, prima facie obviousness has not been presented to justify the combination of the two references. Accordingly, the rejection is deficient. See MPEP 706.02(j) which emphasizes that the Examiner should set forth in the Office Action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

ITEM 4: REJECTION OF CLAIMS 13-14 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER SEKINE ET AL. IN VIEW OF ITOH AND FURTHER IN VIEW OF MATSUDA (U.S. PATENT 6,314,273)

The rejection is respectfully traversed.

Docket No.: 1614.1362

Serial No. 10/664,024

In the above-referenced telephone interview, Applicant's counsel urged that the reference does not teach connection parts provided left and right and configured to foldably connect the first and second chassis, one non-electrically and the other electrically. The Examiner responded, saying that FIG. 41 shows the foldably connected parts (taking the left and right hand views in FIG. 41 together). The Examiner further argued that the right hand view shows the interior connections provided by the hinged arrangement of the left hand view and, thus, that the wires 108, 109, 118 and 119 were incorporated in the hinge structure in the left hand view.

Applicants responded, countering the Examiner's contention by contending there was no suggestion in the reference of either eliminating the wires or incorporating them into the hinge structure.

The Examiner then cited FIG. 62 which has no hinge structure but in which the wire connections of FIG. 41 are incorporated in the hinge structure. Applicant's counsel responded, arguing that there was no such teaching or any basis for her to read such further connections into the structure of FIG. 62. Moreover, Applicant's counsel argued that the notch 101 in the FIG. 62 structure replaces the non-conductive/high resistively connection 109 of the FIG. 41 structure.

The Examiner then cited FIGS. 63A as teaching the combination of a hinged or foldable structure with a high resistively notch 101 -- but Applicant's counsel persuaded her that it was not relevant to the foldable structure of the present invention, since the notch is not defined in relation to first and second hinges, etc. The Examiner then cited various other figures e.g., FIG. 10, as teaching a notch midway of the length of the structure such that it could be foldable about the notch if a hinge were provided -- to which Applicant's counsel objected, as being without basis in the actual teaching of the reference.

NEW CLAIMS 19-24

These dependent claims clarify the nature of the hinge or other structure providing a rotatable interconnection of the first and second chassis and further distinguish over the references of record -- and particularly the "wires" in Sekine relied upon by the Examiner as "connecting" the two chassis.

CONCLUSION

It is respectfully submitted that the patentability of the pending claims over the references and rejections record have been clearly set forth and, there being no other objections or

Docket No.: 1614.1362

Serial No. 10/664,024

rejections, that the application is in condition for allowance, which Action is respectfully requested. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: Sept 6, 2006

By: H. J. Staas

H. J. Staas
Registration No. 22,010

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450
on September 6, 2006
STAAS & HALSEY L.F.
By: 9/6/06
Date: 9/6/06